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Daniel C. Birkestrand

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IBM CORPORATION, INTELLECTUAL PROPERTY LAW  
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EXAMINER

LANIER, BENJAMIN E

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/650,541  
Filing Date: August 28, 2003  
Appellant(s): BIRKESTRAND ET AL.

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Gero G. McClellan  
Reg. No. 44,227  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 18 August 2008 appealing from the Office action mailed 19 February 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claim 28 under 35 USC §112, second paragraph, were withdrawn subsequent to the entry of the amendment filed 21 April 2008, which corrected the identified deficiencies.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

7,146,496	CIRCENIS	12-2006
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**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 28-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Circenis, U.S. Patent No. 7,146,496.

Referring to claims 28, 44, Circenis discloses a capacity on demand system wherein a user can purchase and is provided authorized access to computer system components (Col. 5, lines 23-60), which meets the limitation of recording a compliant state of the computerized apparatus, with respect to the on-demand resource, in which a system function uses the on-demand resource with authorization, wherein on-demand resource is a hardware component of the computerized apparatus. Inactive components that the user has not yet paid for can be temporarily accessed by the user (Col. 5, line 66 – Col. 6, line 3) for a predetermined period (Col. 6, lines 14-17), which meets the limitation of determining an incompliant state of the computerized apparatus, with respect to the on-demand resource, in which the system function uses the on-demand resource without authorization, and initiating a grace period during which the system function continues to use the on-demand resource while in the incompliant state, wherein the computerized apparatus transitions from the compliance state to the incompliant state and then initiates the grace period in a manner providing continuous availability of the on-demand resource to the system function.

Referring to claims 29, 45, Circenis discloses that the capacity on demand computer system is implemented as a partitionable computer system (Col. 8, lines 8-10), which meets the limitation of the system function is a partition manager.

Referring to claims 30, 46, Circenis discloses that the temporary access is for a predetermined period (Col. 6, lines 14-17), which meets the limitation of initiating the grace period comprises initiating a countdown counter.

Referring to claims 31, 47, Circenis discloses that once the period has expired access to the components is prohibited (Col. 8, line 64 - Col. 9, line 16), which meets the limitation of preventing the system function from using the on-demand resource after expiration of the grace period.

Referring to claims 32, 48, Circenis discloses that once a user has purchased additional capacity, the temporary access period is reset to reflect the purchased amount (Col. 9, lines 33-36), which meets the limitation of terminating the grace period if the system is returned to a compliant state.

Referring to claims 33-34, 49, 50, Circenis discloses that the state information is maintained within the computer system (Col. 7, lines 56-59), which meets the limitation of recording the compliant state comprises writing to a smart chip, determining the noncompliant state comprises reading a smart chip.

Referring to claims 35, 51, Circenis discloses that the capacity on demand computer system comprises a processor, memory, and storage (Figure 2).

Referring to claim 36, Circenis discloses a capacity on demand management system wherein a user can purchase and is provided authorized access to computer system components

Art Unit: 2132

(Col. 5, lines 23-60), which meets the limitation of on-demand resources configured to be claimed for use by a function, wherein on-demand resources comprise a hardware component, a capacity manager, which when executed by a processor, is configured to enable the on-demand resources for use by the function, wherein the computerized apparatus is in a compliant state when the function only claims usage of the enabled on-demand resources and does not claim any disabled on-demand resources. Inactive components that the user has not yet paid for can be temporarily accessed by the user (Col. 5, line 66 – Col. 6, line 3) for a predetermined period (Col. 6, lines 14-17), which meets the limitation of initiate a grace period during which the function may continue to use the on-demand resource while in an incompliant state for a defined period of time, wherein the computerized apparatus is in the incompliant state when the function claims usage of the disabled on-demand resources, and wherein the grace period is initiated in response to the computerized apparatus transitioning from the compliant state to the incompliant state, thereby providing continuous availability of the on-demand resources to the function.

Referring to claim 37, Circenis discloses that once the period has expired access to the components is prohibited (Col. 8, line 64 - Col. 9, line 16), which meets the limitation of the capacity manager is further configured to implement an enforcement policy restricting the use of the on-demand resources after expiration of the grace period.

Referring to claim 38, Circenis discloses that the capacity on demand computer system is implemented as a partitionable computer system (Col. 8, lines 8-10), which meets the limitation of the function is a partition manager for managing a plurality of logical partitions.

Referring to claim 39, Circenis discloses that the state information is maintained within the computer system (Col. 7, lines 56-59), which meets the limitation of a persistent storage

Art Unit: 2132

device to store state information used to determine whether the computerized apparatus is in the compliant state or the noncompliant state with respect to the function's claim to usage of the on-demand resources.

Referring to claim 40, Circenis discloses that the capacity on demand computer system comprises a processor, memory, and storage (Figure 2).

Referring to claims 41-43, Circenis discloses that access to the components is allowed once a user has paid for access and has provided a codeword (Col. 7, lines 60-67), which meets the limitation of the capacity manager is configured to enable the on-demand resources by unlocking the on-demand resources and making the on-demand resources available for use upon request, configured to receive enablement codes configured to enable the on-demand resources, configured to determine whether each enablement code is valid by determining whether the enablement code is unique to the computerized apparatus.

#### **(10) Response to Argument**

Appellant argues, “*Circenis* does not disclose recording a compliant state of the computerized apparatus, with respect to the on-demand resource, in which a system function uses the on-demand resource with authorization, and determining an noncompliant state of the computerized apparatus, with respect to the on-demand resource, in which the system function uses the on-demand resource without authorization.” This argument is not persuasive because Circenis discloses a user can purchase rights to use on demand components (Col. 5, lines 35-60). These components that the user is permitted to use as a matter of right based upon what has been paid (Circenis: Col. 5, lines 61-64) would represent the claimed compliant state of the computerized apparatus because the user has been “authorized” to use the on demand

Art Unit: 2132

components to the extent that the user has paid for the use of a predetermined number of the components. Circenis also discloses that the user is permitted to access additional on-demand components outside of what the user has paid for a temporary period (Circenis: Col. 5, lines 56-60, 64-67). These additional components accessed by the user outside of the matter of right (Col. 5, lines 64-67) would represent the claimed noncompliant state of the computerized apparatus because the user has not been “authorized” to use the on demand components to the extent that no payment has been received for the use of these components.

Appellant argues, “the cited portion is simply directed to effectively increasing the temporarily capacity balance for a user that is deemed trustworthy. In doing so, the vendor extends the time period for when a user can activate ICOD components. In other words, a vendor is providing authorization for a user to access these components for the extended period. Therefore, Applicant’s submit that *Circenis* does not disclose the use of on-demand resources without authorization.” This argument is not persuasive because the Examiner is relying on the issue of payment in Circenis to meet the claimed authorization features. Circenis discloses that when the user pays for use of a specific number of on-demand components, the user is allowed temporary access to additional on-demand resources that have not been paid for by the user (Col. 5, lines 23-67). To this extent, “authorization” has not been provided because the user has not paid for use of these additional components.

Appellant argues, “*Circenis* fails to disclose initiating a grace period during which the system function continues to use the on-demand resource while in the noncompliant state, wherein the computerized apparatus transitions from compliance state to the noncompliant state and then initiates the grace period in a manner providing continuous availability of the on-demand



Art Unit: 2132

resource to the system function.” This argument is not persuasive because Circenis discloses that the temporary access has a defined expiration time (Col. 6, lines 30-32). The expiration time can be based on a capacity balance (Col. 9, lines 17-32), which could relate to CPU hours for the components being used in the system (Circenis: Col. 7, lines 52-56). When the user is utilizing more than the predetermined number of authorized components (Col. 7, lines 52-56: number of excess CPUs employed is 4), the user is allowed to use those excess components (CPUs) until the balance reaches a predetermined level (Col. 9, lines 24-25) defines the level as -20.

Therefore, the user would be able to utilize the excess (i.e. unauthorized) components (CPUs) for the amount of CPU hours (Col. 7, lines 52-56) that corresponds to the negative balance discussed in Circenis (Col. 9, lines 24-25). Circenis shows the claimed transition from compliant state to noncompliant state and the initialization of a grace period that provides continuous availability of the on-demand resource because in Circenis, even after the paid capacity balance has reaches zero (Col. 9, lines 17-19), the user is permitted continued access to those components for an additional 20 units until access is denied (Col. 9, lines 24-32).

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Benjamin E Lanier/

Primary Examiner, Art Unit 2132

Conferees:

/Christopher A. Revak/

Primary Examiner, Art Unit 2131

/Gilberto Barron Jr/

Supervisory Patent Examiner, Art Unit 2132